

R E M A R K S

- Claims **1-100** are pending in the present application.
- Claims **1, 29, 37-43, 54-96, 99 and 100** are independent.
- Claims **2-5 and 30-33** have been cancelled.
- Claims **99 and 100**, independent claims, and Claim **98**, a dependent claim, have been added herein.

1. Section 101 Rejection

As the Section 101 rejections have not been continued in the instant Office Action, Applicants will regard the remarks made in response to the Final Office Action, dated December 12, 2003, as persuasive and consider the Section 101 rejections withdrawn.

2. Section 103 Rejections

Claims **1-15, 17-21, 25-41, 43-47 and 49-96** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,112,186 to Bergh (“Bergh” herein) in view of U.S. Patent No. 5,970,469 to Scroggie (“Scroggie” herein) in further view of U.S. Patent No. 5,227,874 to Von Kohorn (“Von Kohorn” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Neither Bergh, Scroggie, or Von Kohorn, alone or in combination, disclose the following claim features:

- selecting, for a customer, at least one of the products from a plurality of products, where the customer had indicated
 - a willingness to purchase at least one but not all of the plurality of products

Similarly, neither Bergh, Scroggie or Von Kohorn discloses receiving from a customer an indication of (i) a plurality of services or two retailers, and (ii) a willingness to purchase at least one but not all of the plurality of services or from either of the two retailers, and then selecting, for the customer, at least one of the plurality of services or

two retailers. Each of the pending claims has been amended herein to claim one of these particular embodiments of the present invention.

In Bergh, a customer may rate specific items but then the system does not recommend those rated items to the customer. Rather, the Bergh system selects different items, ones not indicated by the customer, to recommend to the customer. Further, Bergh does not disclose receiving from a customer a willingness to purchase any item, much less an item to be selected for the customer.

In Scroggie, a customer himself may select particular items to purchase either by selecting the items individually or by selecting a recipe and thus selecting each of the items included in the recipe. In other words, at least one item is not selected for the customer from a plurality of items for which the customer has indicated a willingness to purchase.

In Von Kohorn, a customer identifies a number of items, each of which the customer is interested purchasing at a sale or discounted price. Column 99, lines 49-52. This list is then compared to a list received by a response unit containing a list of items that have been placed on sale or are available at a discounted price. The response unit sounds a bell, prints a list of the discounted items or prints out coupons for the item of interest that have been discounted. The system of Von Kohorn thus requires the customer to indicate a list of items, all of which the customer appears interested in purchasing at a sale or discounted price. Of the items indicated in the list, all, a portion, or none of the items may appear on the list of discounted items. In other words, the system of Von Kohorn, does not necessarily select at least one product from a plurality of products.

Thus, none of the cited references, alone or in combination, teaches or suggests a customer's willingness to purchase at least one but not all of a plurality of products, much less receiving an indication of such from the customer, as now generally recited in each of independent claims **1, 29, 37-41, 56-58, 61-84, 99 and 100**. Von Kohorn, for example, suggests only that the customer is willing to purchase all of the items identified by the customer.

Claims **65 – 68** recite the above steps from the customer's perspective. Since neither Bergh, Scroggie or Von Kohorn disclose the above features from the system's

perspective, it follows that neither Bergh, Scroggie or Von Kohorn disclose the features from the customer's perspective.

Allowing a system to make a selection of a plurality of products, services or retailers that the customer has indicated he is willing to purchase or purchase from has many advantages not recognized by the prior art, as explained in the specification (e.g., page 9, lines 7 through 31). For example, the claimed methods "enables manufacturers or other suppliers of premium brands of products and services to sell products and services to brand indifferent customers at reduced prices without losing revenue on sales of products and services to brand-loyal customers and without brand-dilution."

Specification, page 9, lines 7 – 11.

The following example illustrates the above advantage. Assume it doesn't matter to one customer whether his toothpaste is Brand A or Brand B. This brand indifferent customer may utilize the claimed systems and methods to indicate a willingness to purchase any one of a tube of toothpaste of Brand A and a tube of toothpaste of Brand B. The manufacturer of Brand A, for example, may be willing to offer a significant discount to such a brand indifferent customer in the hopes of converting the customer to a Brand A loyal customer. Another customer, on the other hand, may only be willing to purchase Brand A toothpaste. Such a customer may not be willing to let the claimed system select a tube of toothpaste for the customer from either Brand A or Brand B, due to a concern that Brand B would be selected. Thus, the claimed systems and methods allow manufacturers and other suppliers to differentiate amongst such brand loyal and brand indifferent customers (since only Brand indifferent customers may be willing to use the claimed systems and methods). Thus, the manufacturer of Brand A may better target funds for discounts. Rather than simply offering a discount on Brand A toothpaste (which would provide the discount to both the brand indifferent customer and the brand loyal customer, who would have purchased Brand A even if there was no discount on it), the manufacturer may only offer discounts to brand indifferent customers by identifying those customers via the methods and systems of the present invention.

Claims 16, 22, 23 and 48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bergh in view of Scroggie in view of Von Kohorn in further view of

U.S. Patent No. 5,537,314 to Kanter (“Kanter” herein). Applicants respectfully traverse this rejection for the same reasons discussed in the Response to the Previous Office Action. However, since each of claims **16, 22, 23 and 48** is dependent from an independent claim that includes the features discussed above, Applicants respectfully submit that claims **16, 22, 23 and 48** are patentable at least for the same reasons discussed above.

Claim **97** stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bergh in view of Scroggie in view of Von Kohorn in further view of U.S. Patent No. 5,717,989 to Tozzoli (“Tozzoli” herein). As Claim **97** is dependent from an independent claim that includes the features discussed above, Applicants respectfully submit that Claim **97** is patentable at least for the same reasons discussed above.

3. New Claims 98-100

Claim **98** has been added to explicitly claim the exchange of a benefit for the selection of the product provided to the customer.

Claims **99 and 100** have been added to explicitly claim the same feature in methods for enabling the purchase of a product or service, respectively. Such as feature is not suggested by any of the cited references, alone or in combination.

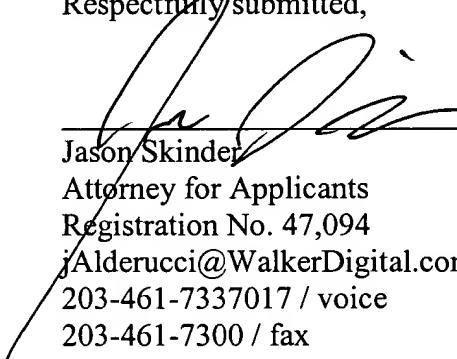
Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at jskinder@walkerdigital.com.

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Date